

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Richard A. Watson, Jr. Art Unit : 2157
Serial No. : 09/893,693 Examiner : El Chanti, Hussein A.
Filed : June 29, 2001 Conf. No. : 4959
Title : ENABLING COMMUNICATIONS OF ELECTRONIC DATA BETWEEN AN INFORMATION REQUESTOR AND A GEOGRAPHICALLY PROXIMATE SERVICE PROVIDER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF (37 C.F.R 41.37)

In response to the notification of non-compliant Appeal Brief dated April 22, 2009, Applicant submits herewith a revised paper in compliance with the requirements of 37 CFR § 41.37. Please note that the after-Final response to the Office Action of December 26, 2007 did not contain any amendments. The brief fee has previously been paid and, therefore, no fees are believed to be due at this time.

Please apply any charges or credits to Deposit Account No. 06-1050

Respectfully submitted,

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6/5/09

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BRIEF ON APPEAL

Appellant hereby submits this Brief on Appeal in response to the final rejection dated October 24, 2007 and further to the Notice of Panel Decision from Pre-Appeal Brief Review dated April 14, 2008.

TABLE OF CONTENTS

<u>Section</u>	<u>Page(s)</u>
I. Real Party in Interest.....	2
II. Related Appeals and Interferences.....	3
III. Status of Claims.....	4
IV. Status of Amendments.....	5
V. Summary of Claimed Subject Matter	6
VI. Grounds of Rejection.....	7
VII. Argument.....	10-15
VIII. Claims Appendix.....	16
IX. Evidence Appendix	21
X. Related Proceedings Appendix	22

Applicant : Richard A. Watson, Jr.
Serial No. : 09/893,693
Filed : June 29, 2001
Page : 2 of 22

Attorney's Docket Ivo.: 06975-088001 / Network 04

I. Real Party in Interest

AOL LLC, the assignee of this application, is the real party in interest.

Applicant : Richard A. Watson, Jr.
Serial No. : 09/893,693
Filed : June 29, 2001
Page : 3 of 22

Attorney's Docket No.: 06975-088001 / Network 04

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of Claims

Claims 30-40, 42-44, and 46-55, and 60-65 are pending and stand rejected, with claims 30, 40, and 42 being independent.

Claims 1-29, 41, and 45 are cancelled.

Claims 56-59 are pending, but presently are withdrawn and are not presently appealed.

Appellants have appealed the rejection of claims 30-40, 42-44, 46-55, and 60-65.

Applicant : Richard A. Watson, Jr.
Serial No. : 09/893,693
Filed : June 29, 2001
Page : 5 of 22

Attorney's Docket No.: 06975-088001 / Network 04

IV. Status of Amendments

No amendments are pending. No amendments to the claims were made in the Response to the Final Office Action filed on December 26, 2007.

V. Summary of Claimed Subject Matter

The following summarizes disclosure related to each independent claim with references to the application specification and drawings. The references to the specification and drawings are meant to be exemplary, and not limiting.

Independent claim 30

Independent claim 30 is directed to a method for enabling electronic communications between the Internet and a client system. See, e.g., specification, p. 11, lines 22-30, p. 17, line 25 - p. 18, line 3, p. 18, lines 15-30; FIGS. 7-8. The method comprises receiving, at a primary communications system configured to act as an access point to the Internet for data communications between the client system and the Internet, a request to access the Internet that is directed to the primary communication system, wherein the request is issued by an online identity operating the client system. See, e.g., specification, p. 11, lines 22-30, p. 17, line 25 - p. 18, line 3, p. 18, lines 15-30; page 19; lines 1-15; page 15, lines 27-28; FIGS. 7-8. The request is processed at the primary communication system. Based on the processed request, a secondary system is identified that is more optimally suited for providing Internet access to the client's system than the primary communications system. See, e.g., specification, p. 11, lines 22-30, p. 17, line 25 - p. 18, line 3, p. 18, lines 15-30; FIGS. 7-8. Finally, the client system's configuration is enabled to direct subsequent Internet access requests from the client system and to use the secondary communications system as an access point to the Internet for subsequent data communications between the client system and the Internet, such that the subsequent data communications between the client and the Internet pass through the secondary communications system. See, e.g., specification, p. 17, line 25- p. 18, line 3, p. 18, lines 15-27, p. 19, lines 7-15; FIGS. 7-8.

Independent claim 40

Independent claim 40 is directed to a method for enabling electronic communications with the Internet at a client system. See, e.g., specification, p. 11, lines 22-30, p. 17, line 25 - p. 18, line 3, p. 18, lines 15-30; FIGS. 7-8. The method comprises submitting a request to access the Internet that is directed to a primary communications system configured to act as an access

point to the Internet for data communications between the client system and the Internet, wherein the request is issued by an online identity operating the client system. See, e.g., specification, p. 11, lines 22-30, p. 17, line 25 - p. 18, line 3, p. 18, lines 15-30; page 19; lines 1-15; page 15, lines 27-28; FIGS. 7-8. From the primary communication system, an indication is received of a secondary communications system that is more geographically proximate to the geographic location of the client system than the primary communications system. See, e.g., specification, p. 11, lines 22-30, p. 17, line 25 - p. 18, line 3, p. 18, lines 15-30. The client system is reconfigured to submit future access requests to the secondary communications system based on the indication received. See, e.g., specification, p. 11, lines 22-30, p. 17, line 25 - p. 18, line 3, p. 18, lines 15-30; FIGS. 7-8. Future requests are submitted to access the Internet from the client system to the secondary communications system. In addition, and the client system is reconfigured to direct communications to the Internet, which are subsequent to access from the client system, to the secondary communications system. See, e.g., specification, p. 17, line 25 - p. 18, line 3, p. 18, lines 15-27, p. 19, lines 7-15; FIGS. 7-8.

Independent claim 42

Independent claim 42 is directed to a method for enabling electronic communications between a client and the Internet at a secondary communications system that is more geographically proximate to a geographic location of the client system than a primary communications system. See, e.g., specification, p. 11, lines 22-30, p. 17, line 25 - p. 18, line 3, p. 18, lines 15-30; page 19; lines 1-15; page 15, lines 27-28; FIGS. 7-8. The method comprises receiving an indication from a primary communications system to process requests to access the Internet that are issued by an online identity operating a client system, where the access requests are configured to enable access to the Internet and where the primary communications system is configured to act as an access point to the Internet for data communications between the client system and the Internet. See, e.g., specification, p. 11, lines 22-30, p. 17, line 25 - p. 18, line 3, p. 18, lines 15-30; FIGS. 7-8. In addition, the method comprises reconfiguring the secondary communications system to process requests to access the Internet from the client system based on the indication received. See, e.g., specification, p. 11, lines 22-30, p. 17, line 25 - p. 18, line 3, p. 18, lines 15-30; FIGS. 7-8. Furthermore, the method comprises receiving data

Applicant : Richard A. Watson, Jr.
Serial No. : 09/893,693
Filed : June 29, 2001
Page : 8 of 22

Attorney's Docket Ivo.: 06975-088001 / Network 04

communications at the secondary communications system subsequent to Internet access by the client system through the secondary communications system. See, e.g., specification, p. 17, line 25- p. 18, line 3, p. 18, lines 15-27, p. 19, lines 7-15; FIGS. 7-8.

VI. Grounds of Rejection

A. Claims 30-40, 42-44, 46-55, and 60-65 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tarnanen et al. (6,904,026).

B. Claims 30, 40, 42, and 49 were rejected under 35 U.S.C. § 112, first paragraph, in the Final Office Action, but the rejection has since been withdrawn in the Advisory Office Action.

VII. Argument

A. The Office Action Of October 24, 2007 Was Improperly Made Final.

The Manual of Patent Examining Procedure cautions against giving undue emphasis to purely "technical" rejections, such as 35 U.S.C. § 112 rejections, over rejections based on the existing prior art. *See MPEP § 706.03.* In the present case, the 35 U.S.C. § 112 rejection was the sole reason for making the Office Action final after Applicant amended his claims. Immediately afterwards, the 35 U.S.C. § 112 rejection was withdrawn in the Advisory Action. Nevertheless, a new non-final Office Action addressing the amended claim limitations in view of the prior art was never issued. Therefore, as of this date, Applicant has not yet received a proper Office Action that evaluates the full language of pending claims in view of the asserted prior art.

Initially, in the Reply from May 8, 2007, Applicant has amended independent claims 30, 40, and 42. Claim 30 was amended to recite "receiving, at a primary communications system configured to act as an access point to the Internet for data communications between the client system and the Internet, a request to access the Internet that is directed to the primary communication system, wherein the request is issued by an online identity operating the client system."¹ *See e.g.*, Reply to Non-Final Office Action of May 8, 2007, page 2. Other independent claims were amended in a similar manner.

Applicant's amendments, however, were not substantively addressed in the Final Office Action from October 24, 2007. While the Office Action stated that Applicant's arguments with respect to the amended claims were moot in view of the *new* grounds of rejection, the only new grounds were based on the "technical" 35 U.S.C. § 112 rejection. Specifically, the Final Office Action rejected the amended claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Nevertheless, this rejection was clearly improper, as evidenced by the fact that it was subsequently withdrawn in the Advisory Action. *See* Advisory Action of January 25, 2008, page. 3.

The only other rejection in the Final Office Action was based on the previously presented 35 U.S.C. § 102(e) rejection of the *old claims*, not the newly amended claims. A careful

¹ Amendments are underlined.

inspection of the Final and Non-Final Office Actions reveals that the grounds for the 35 U.S.C. § 102 (e) rejection of claims 30-40, 42-44, 46-55 in the Final Office Action were copied verbatim from the non-Final Office Action. See non-Final Office Action from February 12, 2007. The language of the 35 U.S.C. § 102(e) rejection did not change since the last Office Action, thus clearly ignoring the newly added limitations. Notably, the new claims 60-65 were also rejected using an omnibus rejection that failed to set forth rationale suggesting how their steps are individually met by the asserted references. See MPEP § 707.07(d).

Because the new limitations were never addressed, Applicant still has not received an Office Action taking these limitations into consideration. However, it is a well-established principle of patent examination that every limitation in the claim must be considered. MPEP § 2106.II.C. Moreover, when setting forth a rejection, the Office Action must clearly communicate its findings, conclusions and their bases to Applicant. MPEP § 2106.VII. Therefore, a new Office Action that properly addresses the limitations added in Applicant's Reply from May 8, 2007 is necessary.

In summary, the finality of the Final Office Action of October 24th 2007 was based solely on an improper 35 U.S.C. § 112 rejection that has since been withdrawn in the Advisory Action. The record is devoid of any evidence to suggest that the amended claims were considered or substantively addressed by the Office. For these reasons, the finality of the Office Action from October 24, 2007 was clearly improper. See MPEP § 706.07(a). The Office should issue a new non-final Office Action that addresses the ignored limitations. Applicant also requests a refund of the USPTO fees that were necessitated by the improperly issued Final Office Action.

B. The Advisory Action From January 25, 2008 Does Not Remedy The Failure Of The Final Office Action To Address The Ignored Limitations, Which Distinguish The Art Of Record

The Advisory Action from January 25, 2008 attempts to discuss the unaddressed limitations from the Final Office Action. However, the Advisory Action once again relies on **the no-longer-pending claim language**. In particular, the Advisory Action states:

In response to applicant's arguments that Tamanen does not teach **a first communication system** that identifies a second communication system acting as an access point, the rejection is maintained because Tamanen teaches a system and method including a mobile station that receives a request to access the Internet from a user and in response, determines an ISP that is

capable of servicing the request (see col. 7 lines 15-45). Since the mobile station enables the user to access the Internet, the mobile station is interpreted to be "first communication [sic] system". There is no claim limitation that suggests that the mobile station may not be interpreted as "first communication system" such as for example stating that the first communication system is a device remote from the client device, therefore examiner believes that the interpretation is reasonable .

See Advisory Action of January 25, 2008, page 3 (emphasis added)

Notably, claim 30 **does not** recite "a first communication system." Instead, claim 30 recites three distinct systems: "a client system," "a primary communications system," and "a secondary communications system." Therefore, it is unclear what the Examiner means by the "first communication system." Such ambiguous explanation is improper under MPEP § 2106.VII, which states that the Examiner's reasoning must be clearly communicated to Applicant. In addition, this is the first time that the Examiner apparently addressed the amended claims (albeit relying on the wrong language), and, as it is well-known, new grounds for rejection should not be introduced in the Advisory Action. See MPEP 706.07.

Furthermore, the reasoning expressed in the Advisory Action is incorrect. For example, even assuming *arguendo* that the Examiner equates the "first communication system" to the "client system," such interpretation is clearly incorrect, since the client system cannot receive a request from itself to access the Internet, as required by claim 30.

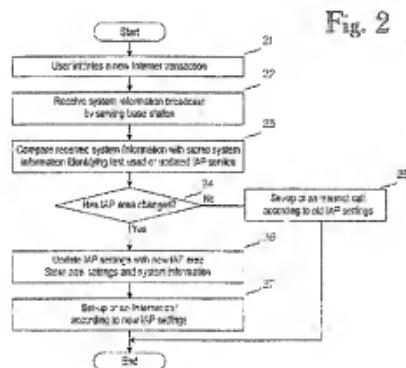
If, on the other hand, the Examiner equates the "first communication system" to the "primary communications system," then the Examiner's reliance on the mobile station of Tamanen to meet this term is also incorrect, since the mobile station in Tamanen acts as "a client system" of claim 30 rather than "a primary communications system." According to claim 30, the primary communications system must receive "a request to access the Internet, wherein the request is issued by an online identity operating the client system." However, the mobile station Tamanen does not receive any requests from another system to access the Internet. In contrast, it actually *generates* these requests, as evidenced by the specification and figures. See FIG. 1 and FIG. 4, Col. 7:15-30. Therefore, the mobile station of Tamanen cannot be "the primary communications system," as it does not perform the functionality of "the primary communications system" that is required from it by the claim language.

Further, as a matter of proper claim construction, the mobile station cannot be interpreted as **both** "a client system" and "a primary communication system," since such interpretation is

inconsistent the well-established law, which states that different claim terms must be presumed to have different meanings. *CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed. Cir. 2000) ("In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings."); *Applied Med. Res. Corp. v. U.S. Surgical Corp.*, 448 F.3d 1324, 1333 n.3 (Fed. Cir. 2006) ("[T]he use of two terms in a claim requires that they connote different meanings. . . ."). Because independent claims 30, 40, and 42 intentionally use distinct terms for "a client system" and "a primary communication system," it is improper for the Examiner to point to a single "mobile station" to meet both limitations, especially in light of the fact that Tarnanen does not use the mobile station as both "a primary communications system" and "a client system," as explained above.

Finally, Applicant submits that the unaddressed limitations overcome the art of record. Tarnanen simply has no regard for a primary communications system that is (1) configured to act as an access point to the Internet for data communications between the client system and the Internet and (2) is capable of identifying a secondary communications system that is more optimally suited for providing Internet access to the client's system than the primary communications system. Rather, in Tarnanen, these tasks are carried out by independent systems through distinct signaling protocols.

Specifically, FIG. 2 of Tarnanen demonstrates the process of IAP (Internet Access Provider) updating from the perspective of a Mobile Station (MS). First, the MS initiates a new Internet transaction through its currently configured IAP (step 21). Based on the information received back from its base station (steps 22-23), the client determines whether it has moved to a new IAP area (step 25), thus requiring an updated IAP connection. If so, the client updates its IAP settings (step 26) and initiates its new Internet call from a more convenient IAP.



Notably, the MS does not obtain its new IAP settings from its current IAP. Instead, the MS obtains the new settings from the Service Center (10, FIG. 1), which is an entirely independent entity from any of the IAPs. Contrast Col. 2:15-30 (IAP) with Col. 4:28-49 (SC). The Service Center uses SMS messaging to providing the MS with updated IAP settings. See FIG. 4, Col. 9:37-Col. 10:13. In addition, the decision to undertake a switch to a different IAP is made at the MS, not the Service Center or the current IAP, and is based on the information received by the MS's from its local base station. See 22, FIG. 2. Finally, Tarnanen neither discloses nor suggests that the Service Center is ever used by the client as an access point to the Internet. The Service Center is accessed by the MS solely for the purpose of obtaining the updated IAP information. Therefore, neither the Service Center nor the IAPs of Tarnanen are configured to act as both access points to the Internet and also as systems capable of identifying more optimal secondary communications systems. In addition, for the reasons explained above, the MS cannot be considered as the "primary communications system," because it acts as "a client system." Therefore, Tarnanen does not teach a suggest a primary communications system that meets all of the limitations of claim 30 and similar independent claims.

Based on the foregoing arguments and remarks, independent claims 30, 40, and 42 are believed to be allowable over the applied reference.

Applicant requests reversal of the rejection of record and either issuance of a new non-final Office Action properly addressing the amended claims or allowance of these claims. Applicant also requests a refund of the USPTO fees that were necessitated by the improperly issued Final Office Action.

Applicant : Richard A. Watson, Jr.
Serial No. : 09/893,693
Filed : June 29, 2001
Page : 15 of 22

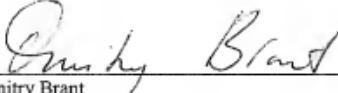
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VIII. Claims Appendix

30. A method for enabling electronic communications between the Internet and a client system comprising:

receiving, at a primary communications system configured to act as an access point to the Internet for data communications between the client system and the Internet, a request to access the Internet that is directed to the primary communication system, wherein the request is issued by an online identity operating the client system;

processing the request at the primary communication system;

identifying at the primary communication system, based on the processed request, a secondary communications system that is more optimally suited for providing Internet access to the client's system than the primary communications system; and

enabling configuration of the client system to direct subsequent Internet access requests from the client system and to use the secondary communications system as an access point to the Internet for subsequent data communications between the client system and the Internet, such that the subsequent data communications between the client and the Internet pass through the secondary communications system.

31. The method of claim 30, wherein processing the request further comprises:

authenticating the online identity or the client system at the primary communications system.

32. The method of claim 30, further comprising enabling configuration of the client system to direct data communications, which are subsequent to access from the client system, to the secondary communications system.

33. The method of claim 30, wherein access to the Internet is granted to the client system by the primary communications system.

34. The method of claim 30, wherein access to the Internet is granted to the client system by the secondary communications system.

35. The method of claim 32, further comprising encapsulating data communications in a tunneling protocol at the secondary communications system.

36. The method of claim 32, further comprising determining whether responses to data communications can be satisfied by electronic data stored in a cache at the secondary communications system.

37. The method of claim 32, further comprising performing filtering of data communications at the secondary communications system.

38. The method of claim 37, wherein the filtering is performed according to contents filtering.

39. The method of claim 30, wherein the primary communications system is an online access provider.

40. A method for enabling electronic communications with the Internet at a client system, comprising:

submitting a request to access the Internet that is directed to a primary communications system configured to act as an access point to the Internet for data communications between the client system and the Internet, wherein the request is issued by an online identity operating the client system;

receiving from the primary communications system, an indication of a secondary communications system that is more geographically proximate to the geographic location of the client system than the primary communications system;

reconfiguring the client system to submit future access requests to the secondary communications system based on the indication received;

submitting future requests to access the Internet from the client system to the secondary communications system; and

reconfiguring the client system to direct communications to the Internet, which are subsequent to access from the client system, to the secondary communications system.

42. A method for enabling electronic communications between a client and the Internet at a secondary communications system that is more geographically proximate to a geographic location of the client system than a primary communications system, comprising:

receiving, from a primary communications system configured to act as an access point to the Internet for data communications between the client system and the Internet, an indication to process requests to access the Internet that are issued by an online identity operating a client system, where the access requests are configured to enable access to the Internet;

based on the indication received, reconfiguring the secondary communications system to process requests to access the Internet from the client system; and

subsequent to Internet access by the client system through the secondary communications system, receiving data communications between the client system and the Internet at the secondary communications system.

43. The method of claim 42, further comprising processing access requests at the secondary communications system.

44. The method of claim 43, wherein processing access requests further comprises:
authenticating the online identity or the client system at the primary communications system.

46. The method of claim 43, wherein access to the Internet is granted to the client system by the secondary communications system.

47. The method of claim 43, further comprising encapsulating data communications in a tunneling protocol at the secondary communications system.

48. The method of claim 43, further comprising determining whether responses to data communications can be satisfied by electronic data stored in a cache at the secondary communications system.

49. The method of claim 43, further comprising:
receiving, from the primary communications system, a subscriber information related to the online identity operating the client system;
performing filtering of data communications between the client system and the Internet at the secondary communications system based on the received subscriber information.

50. The method of claim 49, wherein the filtering is performed according to contents filtering.

51. The method of claim 30, wherein processing the request further comprises determining a geographic location associated with at least one of the online identity and the client system, and wherein the geographic location is used as a basis for configuring the client system to direct subsequent Internet access requests from the client system.

52. The method of claim 30, wherein processing the request further comprises accessing a demographic profile of the online identity.

53. The method of claim 52, wherein the demographic profile includes client-preferred routing paths.

54. The method of claim 52, wherein the demographic profile includes software version of the client system.

55. The method of claim 52, wherein the demographic profile includes the type of communication equipment used for Internet access by the client system.

60. The method of claim 30, further comprising:
- receiving, at a secondary communications system, subsequent data communications between the client and the Internet;
- encapsulating subsequent data communications in an IP tunneling protocol at the secondary communications system; and
- transmitting encapsulated data communications to the Internet using the IP tunneling protocol.
61. The method of claim 49 wherein the subscriber information includes at least one of parental control settings of the online identity or user preferences of the online identity.
62. The method of claim 49 wherein the subscriber information includes a demographic profile of the online identity.
63. The method of claim 62, wherein the demographic profile includes client-preferred routing paths.
64. The method of claim 62, wherein the demographic profile includes software version of the client system.
65. The method of claim 62, wherein the demographic profile includes geographic location of the client system.

Applicant : Richard A. Watson, Jr.
Serial No. : 09/893,693
Filed : June 29, 2001
Page : 21 of 22

Attorney's Docket No.: 06975-088001 / Network 04

IX. Evidence Appendix

None.

Applicant : Richard A. Watson, ...
Serial No. : 09/893,693
Filed : June 29, 2001
Page : 22 of 22

Attorney's Docket No.: 06975-088001 / Network 04

X. Related Proceedings Appendix

None.